

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

REMARKS

Status of the Claims

Claims 1-31 are pending.

Claims 1-31 stand rejected.

I. Claim Rejections under 35 U.S.C. 112

Claims 1-31 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain subject matter, which was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention.

Applicant respectfully traverses the Examiner's rejection fails to provide a prima facie case that the specification does not provide an adequate written description of the invention. The rejection is not supported with any facts or evidence to the contrary to the fact that the specification lacks a sufficient description.

An analysis of the case law provides that the Examiner has the initial burden to produce a prima facie case presenting evidence or reasons why one skilled in the art would not recognize in the specification disclosure a written description of the invention defined by the claims.

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

The Examiner must provide evidence showing how each and every element in the claims is not in the application. Without facts supporting non-possession of each of these elements a rejection under the first paragraph of Section 112 is not proper. See *Ex parte Sorenson*, 3 USPQ2d 1462, 1463 (B.P.A.I. 1987) (citing *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (C.C.P.A. 1976)). See also *Ex parte Parks*, 30 USPQ2d 1234, 1236 (B.P.A.I. 1994).

A review of the decisions of the courts produces a four-part test that must be satisfied by the Examiner or a *prima facie* case of lack of written description is not met. The required elements are as follows:

1. The application does not reasonably describe or convey the concepts
2. to one of ordinary skill in the art
3. at the time of the filing the patent application
4. that the inventor had possession of the claimed invention.

The first test of the written description that the Examiner must address is whether there is a reasonable description that conveys the concepts of the invention and explain why the disclosure does not teach the claimed invention. The element of claim 1 directed toward a heavy

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

weight filler that is no more than 1.95% of the volume of the core is discussed on pages 7 and 8. The Examiner fails to even provide a conclusory statement why the limitation in the specification, while enabling to produce the invention does not satisfy the written description for possession of the invention either expressly or inherently. The table on page 7 that fully supports the volume limitation of the claim in question and thus written description.

The Examiner stated correctly previously that 1.95% by volume relates to the low specific gravity filler zirconium dioxide (5.50), which the specification clearly states occupies a larger volume than the claimed invention relative to that number. Specification teaches that the volume of the filler must be less than 1.95% of the core/center for the benefits of the invention to be present. The volume of the same weight of conventional low specific gravity fillers is too great to meet this limitation and thus if it is arguably not expressly supported it is unquestionably inherently supported.

On page 2, the specification teaches that
"[c]onventional fillers used include calcium carbonate (specific gravity of 2.73), barium sulfate (sp. Gr. Of 4.3)

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

and zinc oxide (sp. Gr. 5.6). Although these materials can be effectively used to increase the weight of a golf ball, the inevitable volume occupied by these materials when incorporated into a center or core results in a reduction in the polymer/rubber of the center or core." (emphasis added) This clearly teaches to one skilled in the art that the volume of the filler used with lower specific gravity fillers is a problem as it reduces the rubber content.

The Applicant provides further teaching to those skilled in the art on page 8 of the specification, which discusses the results of the chart on page 7, "[a]s clearly demonstrated by the test results, the use of heavy weight fillers results in a desirable lower PGA compression and a higher coefficient of restitution relative to a core made with a filler having a lower specific gravity." (emphasis added) Thus the specification clearly teaches to one skilled in the art that the higher specific gravity fillers achieve their benefits through reduced volume of filler. The examiner is directed to review the law and the specification that allows the introduction of a verbal range.

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

In re Eickmeyer, 202 USPQ 655, 662 (C.C.P.A. 1979) the court held that to satisfy the description requirement of section 112, first paragraph, an application must contain sufficient disclosure **expressly or inherently**, to make it clear to one skilled in the art that the appellant was in possession of the subject matter claimed (emphasis added). As discussed above the claimed volume and other ranges are supported expressly, if not inherently on page 7 and 8 of the specification.

The court is clear that the Examiner's basis for a finding of lack of written description must be reasonable. Furthermore the courts have stated that an illustrative example would satisfy the requirements of written description. The Applicant provides teaching that the volume of the heavy filler must be less than that of a conventional filler to provide benefits and provides an illustrative example on page 7. The Examiner has not met the burden to establish why the specification does not enable a volume of 1.95% other than requiring an unreasonably strict written description requirement contrary to the law.

The second part of a prima facie case of lack of written description is providing proof that the

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

specification does not adequately describe the invention concept of the invention claimed to one of ordinary skill in the art. *Ex parte Parks*, 30 USPQ2d 1234, 1236-37 (B.P.A.I. 1993) held that an adequate description does not require literal support for the claimed invention. It is sufficient if the originally filed disclosure would have conveyed to one having ordinary skill in the art that the appellant had possession of the concept of what is claimed. The Applicant's detailed description on page 4 teaches that "[t]he key criteria is that the filler material must have a specific gravity of at least about 5.6." The specification discusses the steps for producing a heavy filler core and refers to the table on page 7 for illustrative examples involving volume and other characteristics.

In re Hayes Microcomputer Prods. Inc. Patent Litig., 982 F.2d 1527, 25 USPQ 2d 1241 (Fed. Cir. 1992) the claims recited a software timer but the specification only described a known microprocessor that one skilled in the art knew could perform a timing function. The Federal Circuit held that the specification sufficiently described how to make and use the invention in broad terms:

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

One skilled in the art would know how to program a microprocessor to perform the necessary steps described in the specification. Thus, an inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains. Disclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of section 112, first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out.

Thus *Hayes Microprocessor* illustrates that the use of functional language is sufficient to enable a specification disclosing and claiming an invention, which would also satisfy the written description. The examples from the Applicant's specification provides the written description sufficient to one skilled in the art to possession of the invention having a filler volume of 1.95% or less. The Examiner's fails to even make a statement that one skilled in the art of golf ball manufacture would not have sufficient written description of a volume of less than 1.95% for the heavy filler, and thus it is not a reasonable rejection.

The third element of forming a valid prima facie case of written description is whether the language was present at the time of filing of the Application. The Examiner has not made any assertion that the specification has been

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

amended or contains any matter not present during the original filing. The requirements that the table discloses 1.95% by volume of zirconium dioxide present in the core and 0.48% by volume of tungsten have been present since file. The Examiner correctly concedes that the claimed volumes of 1.95% and 0.48% are enabled and taught by the specification. The Examiner is incorrect that the values between zero and 1.95% are new matter.

In *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 3 USPQ 2d 1737, 1743 (Fed. Cir.) cert. denied, 484 U.S. 954 (1987) the Federal circuit stated:

If an invention pertains to an art where the results are predictable, e.g., mechanical as opposed to chemical arts, a broad claim can be enabled by disclosure of a single embodiment . . . and is not invalid for lack of enablement simply because it reads on another embodiment of the invention which is inadequately disclosed.

The Examiner rightly concedes that the specification is enabled for a volume of 1.95% and 0.48%. Volume is clearly part of the mechanical arts and volumes can be determined by one skilled in the art using Applicant's specification for guidance. The claimed range of a volume of less than 1.95% is clearly enabled and page 8 satisfies the written description. There is no requirement that the

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

claims must be an exact copy of the specification for compliance with the written requirement, nor does it require providing examples for the all the remaining heavy fillers claimed.

The fourth element that must be proven to establish a valid prima facie case of nonenablement is that the claim is not enabled to one skilled in the art. The Examiner has failed to show that the volume of less than 1.95% of a core or center, described in the specification is not in compliance with the written description.

In *In re Naquin*, 398 F.2d 863, 158 USPQ 317, 319 the court held that "[t]he specification need describe the invention only in such detail as to enable a person skilled in the relevant art to make and use it." When the holding of *Naquin* is applied to the present facts, the application is sufficient regarding a volume range.

The Applicants have shown with the above arguments and case law that the rejection under 35 USC 112, paragraph one is not proper. A valid prima facie case of insufficient written description requires that the Examiner proves each of the four required elements are not present in the rejected claims. None of the elements have been shown to

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

reasonably exist by the examiner. Applicant respectfully requests that the rejection be reconsidered and removed.

II. New Matter rejection

Claims 1, 3, 7, 12 and 22-29 are rejected for containing new matter. The rejection is traversed by the Applicant as an improper rejection on its face. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323, 326 (C.C.P.A. 1981) has discussed the requirements of a proper new matter rejection, as follows:

Broadening a claim does not add new matter to the disclosure. Disclosure is that which is taught, not that which is claimed. An applicant is entitled to claims as broad as the prior art and his disclosure will allow. The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure, therefore is Section 112, first paragraph, not Section 132. The latter section prohibits addition of new matter to the original disclosure. It is properly employed as a basis for objection to amendments to the abstract, specifications, or drawings attempting to add new disclosure to that originally presented.

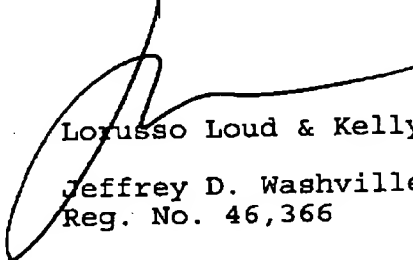
Therefore the rejection of the claims for new matter is not correct. If the claims were actually rejected under 112, first paragraph the arguments provided above prove that there is not a prima facie case of lack of written description because all numbers and ranges were specifically disclosed and ranges claimed.

Appl. No. 09/863,910
Resp. Dated Oct. 28, 2004
Reply to Office Action of May 28, 2004

III. Conclusion

The applicant respectfully requests reconsideration and removal of all rejections of claims 1-31 in light of the enclosed arguments. The applicant courteously solicits a notice of allowance.

Respectfully submitted,



Lorusso Loud & Kelly LLP

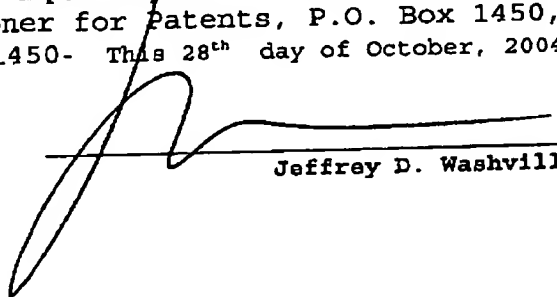
Jeffrey D. Washville
Reg. No. 46,366

Date: October 28, 2004

15 Rye Street, Suite 312
Pease International Tradeport
Portsmouth, NH 03801
Tel.: (603) 427-0070
FAX: (603) 427-5530

Certificate under 1.8

The undersigned hereby certifies that this paper along with any paper or document referred to therein as being attached or enclosed, is being faxed to (703) 872-9306 or deposited with the United States Postal Service to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450- This 28th day of October, 2004.



Jeffrey D. Washville